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IN THE
Supreme Court of the United States
October Term, 1964

HAZELTINE RESEARCH, INC.
and ROBERT REGIS,
Petitioners,

vs.

DAVID L. LADD,
Commissioner of Patents,
Respondent.

No. -----

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA**

Petitioners (Plaintiffs below), Hazeltine Research, Inc. and Robert Regis, respectfully pray that a Writ of Certiorari issue to the United States Court of Appeals for the District of Columbia to review a Judgment of that Court entered November 25, 1964, affirming a Judgment of the United States District Court for the District of Columbia entered February 14, 1964, dismissing Petitioners' Complaint, which sought a Judgment that Petitioners were entitled to receive Letters Patent on the invention claimed in claims 1, 2, and 3 of an application for United States Letters Patent Serial No. 704,770, filed December 23, 1957, and authorizing the Commissioner of Patents to issue Letters Patent to Plaintiffs on aforesaid invention, pursuant to Title 35 United States Code, Section 145 (66 Stat. 792).

I. OPINIONS BELOW

The Opinion of the Court below appears at page 1a* and is reported at — F. 2d — and 143 USPQ 337. The Opinion of the District Court appears at page 3A. It is also reproduced in the Joint Appendix,** page 69A, and is reported at 226 F. Supp. 459 and 140 USPQ 444. The decision of the Board of Appeals of the Patent Office is reproduced at page 9A.

II. JURISDICTION

The jurisdiction of this Court is invoked under Title 28 United States Code, Section 1254(1) (62 Stat. 928) and Title 28 United States Code, Section 2101(c) (63 Stat. 104); and under Rule 22(3) of the Rules of this Court.

The Judgment of the Court below was entered November 25, 1964.

No Petition for Rehearing was filed in the Court below and there has been no extension of time for filing this Petition. Jurisdiction of the District Court was invoked under Title 35 United States Code, Section 145 (66 Stat. 792) and under the Administrative Procedure Act of June 11, 1949, as amended (Title 5, United States Code, Section 1009).

The jurisdiction of the Court of Appeals to review the Judgment of the District Court was invoked under the provisions of Title 28 United States Code, Section 1291 (62 Stat. 869).

III. REASONS RELIED UPON FOR GRANTING THE WRIT

1. There is a direct conflict between the decisions of the Courts of Appeals of the several Circuits on an important point of law which has not been, but should be, decided by this Court.

* Page numbers including the suffix "a" refer to the Appendix of this Petition.

** For brevity, references to the Joint Appendix filed in the Court below are given as "JA".

2. The questions presented by this Petition recurrently arise in proceedings upon applications for Letters Patent within the United States Patent Office and in proceedings in the Courts to enforce such patents and are matters of great importance to the public.

IV. QUESTIONS PRESENTED

The questions presented are:

1. Whether a "copending patent",* which is maintained in secrecy in the Patent Office until it issues, is a part of the general fund of knowledge or "prior art", as that term is used in Title 35 United States Code, Section 103, as of its filing date or as of its issue date.

2. Whether such a "copending patent", as of its filing date, is a bar to the grant of a patent or invalidates an issued patent only if it describes the entire invention of the patent application or patent in issue.

V. THE STATUTES INVOLVED

This Petition involves a consideration of the following statutes:

Title 35 U. S. Code, Section 102:

"§ 102. Conditions for patentability; novelty and loss of right to patent

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

* A "copending patent" is one *issued after* the filing date of a patent application or patent against which it is cited, but based upon an application *filed before* the patent application or patent in issue.

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

“(c) he has abandoned the invention, or

“(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

“(f) he did not himself invent the subject matter sought to be patented, or

“(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.” (66 Stat. 797)

Title 35 U. S. Code, Section 103:

“§ 103. Conditions for patentability; non-obvious subject matter

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” (66 Stat. 798)

Title 35 U. S. Code, Section 122:

"§ 122. Confidential status of applications

"Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner." (66 Stat. 801)

Title 35 U. S. Code, Section 145:

"§ 145. Civil action to obtain patent

"An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant." (66 Stat. 803)

VI. STATEMENT OF THE CASE

Petitioner Robert Regis (Regis) on December 23, 1957, filed an application for Letters Patent, Serial No. 704,770, in the United States Patent Office (JA 7a-15a) for a Microwave Switch, which application was duly assigned to Petitioner Hazeltine Research, Inc. (Hazeltine) (JA 47a). All of the claims of that application were finally rejected by the Patent Office Examiner (JA 23a) "as being unpatentable over" Wallace et al Patent No. 2,822,526 (JA 54a) "in view of" Carlson Patent No. 2,491,644 (JA 50a) and

that rejection was affirmed by the Patent Office Board of Appeals (p. 9A; JA 65a).

Seeking a review of the Patent Office decisions, Petitioners, under the provisions of Title 35 U. S. Code, Section 145 (*supra*, p. 5), filed their Complaint in the District Court for the District of Columbia, seeking a Judgment that the Court authorize and direct the Commissioner of Patents to issue Letters Patent to Regis on his invention as described and claimed in his application (JA 1a).

The subject matter of the Regis patent application and the Wallace et al and Carlson patents is technically complex, but, fortunately, the issues raised on this Petition do not involve an understanding or even a consideration of such technical subject matter. Respondents in the Courts below did not contend that either of these two reference patents individually anticipates the Regis invention or precludes the grant of a patent thereon. What the Respondents below contended was that, as an engineering matter, it was obvious to combine the teachings of the Wallace et al and Carlson patents to produce the structure defined by Regis.

Petitioners' position is that the Wallace et al patent, as a matter of law, is not competent evidence to show whether or not the combination suggested by Respondents

“ . . . would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . . ” (Title 35, U. S. Code, Section 103; *supra*, p. 4)

Petitioners' position is based on the fact that at the time Regis made his invention and filed a patent application thereon on December 23, 1957, the Wallace et al disclosure was contained solely in an application maintained in secrecy in the Patent Office in compliance with Title 35 U. S. Code, Section 122 (*supra*, p. 5). The Wallace et al disclosure, prior to its issuance on February 4, 1958, was

not available to contemporary workers in the art. That is, it was not available

“ . . . at the time the invention was made to a person having ordinary skill in the art . . . ” (Title 35 U. S. Code, Section 103; *supra*, p. 4)

The application for the Wallace et al patent having been filed on March 24, 1954, before Regis filed his application on December 23, 1957, but having first been made public when it issued on February 4, 1958, *after* Regis' filing date, is generally termed a “copending patent”. This is consonant with the definition of the Trial Court (JA 70a; footnote 1).

VII. ARGUMENT

General

Section 102 of the Patent Act of 1952 (Title 35 U. S. Code 102; *supra* pp. 3-4) contains the basic provisions of the Patent Laws setting forth the conditions precedent to the grant of a patent. That Section states that “A person shall be entitled to a patent unless” certain bars exist. Respondents in the Courts below did not contend that the grant of a patent to Regis is barred by any of the circumstances set forth in this Section. The only portion of this Section 102 of possible relevance is subsection (e), reading:

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, * * *”

The quoted subsection, by its explicit terms, applies only to a single copending patent in which an earlier inventor discloses “the invention”; that is, *the entire invention*—not just some part of it. Respondents in the Courts below did not contend, and the Courts did not find, that either the Wallace et al patent or the Carlson patent discloses “the invention” of Regis or that the disclosure of

either of those reference patents alone rendered the Regis claims unpatentable.

However, Section 103 of the Act (Title 35 U. S. Code, Section 103; *supra*, p. 4) is effectively a caveat to Section 102. It sets forth the criteria for determining whether or not a claimed invention is patentable over a group of prior patents or publications or both, no individual one of which discloses or describes "the invention", that is, *the entire invention*. Such prior patents and publications make up that general fund of knowledge which is collectively referred to as the "prior art"—a term used in Section 103, but nowhere explicitly defined in the patent statutes. It is this "prior art" which is used as a yardstick in measuring the quantum of advance represented by an asserted invention to determine its patentability.

A helpful guide in the interpretation of Section 103 is found in the Report from the Committee on the Judiciary of the House of Representatives, House Report 1923, 82nd Congress, May 12, 1952. That Report, in referring to Section 103, states:

"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. *An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent.* That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. *It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102.* If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented." (p. 7; emphasis added.)

Here, we have a definition of the term "prior art", that is, "meaning what was known before as described in section 102". However, this reference back to Section 102 can only be to subsection 102(a), both because that subsection is the only one referring to what "was known * * * before" and because the remaining subsections are obviously inapplicable; for example, subsection (c) recites only that the inventor has abandoned his invention.

Therefore, it becomes necessary to turn back to subsection 102(a) for a definition of what "was known * * * before". Again, the Committee Report is instructive:

"Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty.

*"Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public. (p. 6)**

"Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed., § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

"No change is made in these paragraphs other than that due to division into lettered paragraphs. *The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, 'known' has been held to mean 'publicly known') is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of Title 35 U. S. C., 1946 ed., § 72 (R. S. 4923)."* (p. 17) (Emphasis added)

In brief, the Reviser's Notes on Section 103 equate the term "prior art" to "what was known before, as described in Section 102". But again, the Reviser's Notes on Section

* (Quoted with approval in *Rem-Cru Titanium v. Watson* (D. D.C., 1957) 152 F.Supp. 282; 114 USPQ 529.)

102 limit what was known before to what was *publicly* known. It follows that the term "prior art" is confined to *prior public knowledge*.

Whenever patents are combined in making a rejection, it is on the authority of Section 103, and it seems clear that the combination could not be obvious "to a person having ordinary skill in the art" until such time as patents to be combined have all issued and are available to persons skilled in the art, that is, are publicly known.

The "interpretation by the Courts" that prior knowledge, referred to in Section 102, "excludes various kinds of private knowledge not known to the public", is found in an unbroken line of authorities. For example, in the early case of *Pennock and Sellers v. Dialogue* (1829) 27 U. S. 1, 18, 19, 20, this Court said:

"By the very terms of the first section of our statute, the secretary of state is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c. &c. '*not known or used before the application?*' * * * (Emphasis Court's)

"We think, then, the true meaning must be, not known or used by the public, before the application * * *,"

and referring to an earlier English Statute:

"The use here referred to has always been understood to be a public use, * * *."

The same rule was enunciated by this Court in *Gayler et al. v. Wilder* (1850) 51 U. S. 477, in considering a case based upon the Patent Act of 1836, containing the same limitation upon the grant of a patent, that is, that the invention shall be "not known or used by others":

"The act of 1836, ch. 357, Sec. 6, authorizes a patent where the party has discovered or invented a new and useful improvement, 'not known or used by others before his discovery or invention' * * *

The clause in question qualifies the words before used and shows that *by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public.*" (pp. 496-497; emphasis added)

In summary, there are, *inter alia*, three distinct and independent bars to the grant of a patent on an invention:

1. The invention was not new, having been disclosed entirely or with inconsequential variations in an issued patent or printed publication bearing a date before the invention was made (Section 102(a)) or more than one year before a patent application thereon was filed (Section 102(b)). In this case, Respondent did not contend in the Courts below that either of the reference patents cited by the Patent Office discloses the entire invention or comes within the provisions of these sections of the Patent Statutes.

2. Although the invention was new to the applicant for a patent, the complete invention actually had been made earlier by another who had filed an application thereon in the Patent Office prior to the application in question, which later issued as a patent (copending patent; Section 102(e)). This bar to the grant of a patent is solely and exclusively on the basis that the copending patentee was the "prior inventor" under the case of *Alexander Milburn v. Davis-Bournonville* (1926) 270 U. S. 390, the decision in which was codified by Section 102 (e).

3. While the invention in question was new, the quantum of newness, measured against the "prior art" as defined above, was not sufficient to support the grant of a patent (Section 103). This is the section of the Patent Statutes on which Respondent relied in the Courts below. The controversy arises, therefore, as to whether the "prior art", meaning "what was (publicly) known before", embraces copending patents which were *not publicly known* as of the dates of their filing in the Patent Office but, on the contrary, were maintained in complete secrecy under

Section 122 of the Patent Statutes (*supra*, p. 5). This is the gravamen of the two questions presented on this Petition (*supra*, p. 3).

Unfortunately, a considerable amount of confusion is found in a number of the decisions because the lines of demarcation between the foregoing distinct and different bars to the grant of a patent, based on different sections of the Statute, have not been maintained. Particularly, the term "prior art" has been used loosely and synonymously with "anticipation" and other bars to the grant of a patent embracing evidence falling within the several subsections of Section 102 and Section 103. It is the object of the present Petition to cut away that confusion and to establish an authoritative line of demarcation between the several bars to the grant of a patent set forth in Sections 102 and 103.

POINT 1—There is a Direct Conflict between the Decisions of the Courts of Appeals of the Several Circuits on an Important Point of Law which has not been, but should be, Decided by this Court

Prior to the enactment of the current Patent Act in 1952, there was a legion of conflicting decisions dealing with the question of whether a copending patent is a part of the "prior art", as that term is generally defined by the authorities, as of its filing date or of its issue date. These decisions are cited hereinafter. Since the conflict arose primarily from conflicting interpretations of the decision of this Court in *Alexander Milburn v. Davis-Bournonville*, *supra*, it was initially thought that the conflict was resolved upon passage of the 1952 Patent Act (Title 35, U. S. C.), Section 102(e) of which codified the rule of that decision consonant with Petitioners' position here.

Nevertheless, even after the 1952 Patent Act, the conflict has continued unabated in direct appeals from the Patent Office to the Court of Customs and Patent Appeals; in Civil Actions against the Commissioner of Patents under

Section 145 of the Act (*supra*, p. 5) such as the instant Action; and in patent infringement litigation.

Neglecting for the moment the decisions of the lower Courts, the question of the competence of a copending patent, as of its filing date, to show the state of the prior art has received conflicting answers in the several Federal Appellate Courts. In each of the following cases, the Appellate Court has held that a copending patent is *not* embraced within the prior art as of its filing date but only as of its issue date.

DECISIONS AFTER THE 1952 PATENT ACT:

Weatherhead v. Drillmaster Supply (C. A. 7, 1955)
227 F. 2d 98; 107 USPQ 184;

Helene Curtis v. Sales Affiliates (C. A. 2, 1956)
233 F. 2d 148;

John Blue v. Dempster Mill (C. A. 8, 1960) 275
F. 2d 668; 124 USPQ 485.

DECISIONS BEFORE THE 1952 PATENT ACT:

In re Spencer (CCPA, 1931) 47 F. 2d 806; 8 USPQ
565;

Stelos Company v. Hosiery Motor-Mend (C. A.
2, 1934) 72 F. 2d 405; 23 USPQ 35;

In re Youker (CCPA, 1935) 77 F. 2d 624; 25 USPQ
421;

Hazeltine Corp. v. Coe (C. A. D. C., 1936) 85 F. 2d
558; 31 USPQ 405;

In re Walker et al. (CCPA, 1938) 99 F. 2d 976;
39 USPQ 485;

Comolite v. Davidovicz (C. A. 2, 1940) 111 F. 2d
121; 45 USPQ 241;

Old Town v. Columbia Ribbon (C. A. 2, 1947) 159
F. 2d 379; 72 USPQ 57;

Conmar v. Universal Slide (C. A. 2, 1949) 172 F. 2d 150; 80 USPQ 108;

Permo v. Hudson-Ross (C. A. 7, 1950) 179 F. 2d 386; 84 USPQ 305;

Industrial Wire Cloth v. United Specialties (C. A. 6, 1951) 186 F. 2d 426; 88 USPQ 338.

Thus, the Courts of Appeals of the Second, Sixth, Seventh, and District of Columbia Circuits and the Court of Customs and Patent Appeals have held that a copending patent is not embraced within the prior art as of its filing date. In *Weatherhead v. Drillmaster, supra*, Judge Swaim stated the point succinctly:

“In *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F. 2d 379, 72 USPQ 57, the same court, in an opinion by the same judge, held that the first of copending patents was *not* prior art as to the others, and that it could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention. *This is the position taken in most modern cases in the Courts of Appeals.* B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co., 1 Cir., 122 F. 2d 900, 913, 51 USPQ 198, 211; *Sherwin-Williams Co. v. Marzall*, D. C. Cir., 190 F. 2d 606, 89 USPQ 208.” (Emphasis added)

Unhappily, in addition to the decisions of the Courts below in the instant Action, an impressive array of decisions of the Federal Appellate Courts have held oppositely:

DECISIONS AFTER THE 1952 PATENT ACT:

Syracuse v. H. Daust (C. A. 8, 1960) 280 F. 2d 377; 126 USPQ 326;

In re Kander (CCPA, 1963) 312 F. 2d 834; 136 USPQ 477;

In re Zenitz (CCPA, 1964) 333 F. 2d 924; 142 USPQ 158;

In re Harry (CCPA, 1964) 333 F. 2d 920; 142 USPQ 164.

DECISIONS BEFORE THE 1952 PATENT ACT:

- Denaro v. Maryland Baking* (D. C. Md., 1930) 40 F. 2d 513; 5 USPQ 400 (Affirmed *per curiam* (C. A. 4, 1931) 40 F. 2d 1074; 10 USPQ 80);
- Minnesota Mining v. Coe* (C. A. D. C., 1938) 100 F. 2d 429; 38 USPQ 513 (Cert. den. 306 U. S. 662);
- L. Sonneborn Sons v. Coe* (C. A. D. C., 1939) 104 F. 2d 230; 41 USPQ 5;
- Dyer v. Coe* (C. A. D. C., 1941) 125 F. 2d 192; 52 USPQ 52;
- Western States v. S. S. Hepworth* (C. A. 2, 1945) 147 F. 2d 345; 64 USPQ 141;
- Sherwin-Williams v. Marzall* (C. A. D. C., 1951) 190 F. 2d 606; 89 USPQ 208.

Thus, the Courts of Appeals of the Fourth and the Eighth Circuits and the later decisions of the Court of Appeals of the District of Columbia Circuit and the Court of Customs and Patent Appeals have adopted the rule that a copending patent is competent evidence of the prior art as of its filing date.

This Court should resolve this important conflict of patent law.

The Respondent, in the Courts below, urged that this Court, in *Detrola v. Hazeltine* (1941) 313 U. S. 259, decided the questions presented on this Petition. A careful examination of that decision and of the petition and briefs on which the case was submitted shows clearly that these questions were neither presented nor decided in the *Detrola* case.

While, in *Detrola*, this Court did group together previously issued and copending patents as references and said that "All constituted prior art." (p. 265), this statement is footnoted to the *Alexander Milburn* case, *supra*, which involved solely the issue of prior inventorship (now codified in Section 102(e)), not the question of the quantum

of invention over the prior art (Section 103). The intent of this Court in the *Detrola* decision is thus clear—a copending patent can properly be employed in the same manner as in the *Alexander Milburn* case to establish prior invention by another. This is borne out by an analysis of the Court's actual holding in that case, namely:

“* * * that Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, notwithstanding the fact that he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor,” (p. 269)

In *Old Town Ribbon and Carbon, supra*, Judge Learned Hand, a recognized authority on the patent law, rendered his decision less than six years after the *Detrola* case and unquestionably accorded the decision of this Court the respect it was due. Notwithstanding the *Detrola* case, Judge Hand stated that a copending patent was not within the prior art and could invalidate claims of the patent in suit only on the issue of prior inventorship.

In any event, even if the *Detrola* decision did hold as urged by Respondent in the Courts below, to the extent that it is inconsistent with latest Congressional action, represented by the 1952 Patent Act, it must give way to that Act.

**POINT 2—The Questions Presented by this Petition Recur-
rently Arise in Proceedings upon Applications for
Letters Patent within the United States Patent
Office and in Proceedings in the Courts to Enforce
such Patents and are Matters of Great Importance
to the Public**

In addition to the twenty-four decisions, cited above, in each of which was presented and decided the question of the competence of a copending patent to show the state of the prior art as of its filing date, the many decisions of

the lower Courts and the Patent Office tribunals on this very question are a clear indication of the frequency with which it arises and of its importance to the patent system as a whole. There follows a partial chronological list of decisions of lower tribunals which include rulings on the questions here presented, without regard to the nature of the ruling:

- Ex parte Thomas*, 1918 C. D.* 11;
Ex parte Allen, 1919 C. D. 105;
Hazeltine Corp. v. Electric Service Engineering
 (S. D. N. Y., 1926) 18 F. 2d 662;
In re Downs and Craver (CCPA, 1930) 45 F. 2d
 251; 7 USPQ 316;
American Tri-Ergon et al. v. T. E. Robertson (Sup.
 Ct. D. C., 1931) 11 USPQ 168;
Allied Metal v. Standard (E. D. N. Y., 1932) 57
 F. 2d 296; 13 USPQ 50;
Ex parte Bowles (Bd. App., 1934) 24 USPQ 266;
Ex parte Gilbert (Bd. App., 1935) 28 USPQ 489;
Ex parte Graebner (Bd. App., 1936) 31 USPQ 288;
Baltimore v. Oles (D. Md., 1936) 13 F. Supp. 951;
 29 USPQ 11 (Aff'd. on other grounds (C. A.
 4, 1937) 89 F. 2d 279; 33 USPQ 267);
Aero v. Fenwick (S. D. N. Y., 1937) 19 F. Supp.
 846; 35 USPQ 82 (Reversed on other grounds
 (C. A. 2, 1938) 97 F. 2d 363; 38 USPQ 153);
Utah Radio v. Delco (W. D. N. Y., 1938) 24 F.
 Supp. 328; 38 USPQ 400;
Western States v. Hepworth (E. D. N. Y., 1943)
 51 F. Supp. 859; 58 USPQ 102;
Barnes v. International Harvester (N. D. Ill., 1944)
 51 F. Supp. 254; 58 USPQ 131;
Robinson Aviation v. Barry (D. Mass., 1952) 106
 F. Supp. 514; 95 USPQ 78;
East Rutherford Syringes v. Omega (D. N. J.,
 1957) 152 F. Supp. 497; 114 USPQ 147.

* Decisions of the Commissioner of Patents.

VIII. CONCLUSION

It is submitted that the decisions of the Federal Appellate Courts on the evidentiary competence of a patent issued on an application filed before, but issued after, the date of invention or the date of the application of the patent *sub judice*, are in a hopeless state of confusion and that the great number of decisions of the Appellate and Trial tribunals attest to the frequency of occurrence and the importance of this question. This Court should resolve that confusion.

Respectfully submitted,

LAURENCE B. DODDS,
Attorney for Petitioners.

Of Counsel:

EDWARD A. RUESTOW
GEORGE R. JONES

APPENDIX

**UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT**

No. 18,563

HAZELTINE RESEARCH, INC., et al., APPELLANTS

v.

DAVID L. LADD, Commissioner of Patents, APPELLEE

**Appeal from the United States District Court
for the District of Columbia**

Decided November 25, 1964

Mr. Edward A. Ruestow, with whom *Mr. George R. Jones* was on the brief, for appellants.

Mr. S. William Cochran, Attorney, United States Patent Office, with whom *Mr. C. W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before **BASTIAN, WRIGHT and McGOWAN**, Circuit Judges.

PER CURIAM: The question involved in this case is whether a copending patent is part of the "prior art" within the meaning of that term as used in 35 U.S.C. § 103, and whether a copending patent is a bar to a patent application only if it actually describes the invention for which patent is sought.

Having been unsuccessful in the Patent Office in their application for patent, appellants [plaintiffs] filed suit in the District Court to obtain a judgment authorizing ap-

appellee [defendant], Commissioner of Patents, to issue the patent applied for by them. The District Court, after a full hearing, rendered an opinion finding for appellee and against appellants, and dismissing the complaint. *Hazeltine Research, Inc. v. Ladd*, 226 F. Supp. 459 (D.D.C. 1964).

We are in agreement with the opinion of the District Court. Accordingly, it follows that the judgment of the District Court must be and is

Affirmed.

1-2

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

CIVIL ACTION

No. 1688-62

HAZELTINE RESEARCH, INC., and ROBERT REGIS,
Plaintiffs,

vs.

DAVID L. LADD, Commissioner of Patents,
Defendant.

(Filed Feb. 14, 1964)

OPINION

This civil action was brought pursuant to 35 U.S.C. 145 to obtain judgment authorizing the defendant, Commissioner of Patents, to issue a patent containing claims 1 to 3 of an application Serial No. 704,770 filed December 23, 1957, by the co-plaintiff, Robert Regis. The invention relates to microwave switches.

The tribunals of the Patent Office rejected the claims as unpatentable over the Wallace et al patent No. 2,822,526, in view of the Carlson patent No. 2,491,644. Counsel for plaintiffs concedes that if Wallace et al is available as "prior art" under 35 U.S.C. 103, the combination of Wallace et al with Carlson negates the patentability of the claims. Thus, the sole issue before this Court is whether the Wallace et al patent is "prior art" within the meaning of that term as used in 35 U.S.C. 103.

Counsel for plaintiffs strongly contend that since Wallace et al was a "copending patent",¹ it is "prior art" only with regard to 35 U.S.C. 102(e),² and not with regard to 35 U.S.C. 103.³ If that contention is correct, the judgment here must be in favor of the plaintiffs since neither the Wallace et al patent, nor the Carlson patent alone anticipates the invention described in the claims in suit.

Before specifically considering plaintiffs' contention, it may be noted that prior to the 1952 Patent Act, the Supreme Court in *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259, recognized that "copending patents" could be used to invalidate the claims involved in the infringement suit even though none of those patents anticipated the claims.

¹ Although this term is indefinite, it will be used hereinafter to designate patents issued on applications filed *before*, but issuing *after* the filing date of the application or patent which it is cited against as evidence that the claims of said application or patent are unpatentable. For instance, in this case the Wallace, et al application was filed on March 24, 1954, the Regis application was filed on December 23, 1957, and the Wallace, et al application matured into a patent on February 4, 1958.

² This paragraph is a codification of the rule of the first important case in this area, *Alexander Milburn v. Davis-Bournonville*, 270 U.S. 390. Revisor's Note—35 U.S.C.A. 102.

The paragraph reads as follows:

"A person shall be entitled to a patent unless—

• • • •

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the application (sic) for patent,"

³ The pertinent portion of this section reads as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought be patented and the *prior art* are such that the subject matter as a whole would have been obvious at the time the invention having ordinary skill in the art" (sic)

Moreover, in this Circuit, it was well settled that "copending patents", either singly or in combination with other "copending patents", or other patents, or both, are available as references to show that the claimed advance over the prior art required only the exercise of the skill of the art. *Sherwin-Williams Co. v. Marzall*, 190 F.2d 606, 89 U.S.P.Q. 208 (D.C. Cir. 1951); *Dyer v. Coe*, 125 F. 2d 192, 52 U.S.P.Q. 52 (D.C. Cir. 1941), and *Minnesota Mining & Manufacturing Co. v. Coe*, 100 F.2d 429, 38 U.S.P.Q. 513 (D.C. Cir. 1938). But see *Hazeltine Corp. v. Coe*, 87 F.2d 558, 31 U.S.P.Q. 405 (D.C. Cir. 1936).⁴

The Court of Customs and Patent Appeals had also consistently held that "copending patents" were available as references. *In re Downs*, 45 F.2d 251, 7 U.S.P.Q. 316 (C.C.P.A. 1930); *In re Seid*, 161 F.2d 229, 73 U.S.P.Q. 431 (C.C.P.A. 1947), and *In re Youker*, 77 F.2d 624, 25 U.S.P.Q. 421 (C.C.P.A. 1935).

Thus, prior to the Patent Act of 1952, it is clear that as far as the Patent Office and this Court were concerned, a "copending patent" could be used as evidence to show that claims are unpatentable because the differences between the claims' subject matter and the disclosure of the "copending patent" were within the ingenuity and skill possessed by an ordinary mechanic acquainted with the art.

Counsel for plaintiffs contends that the Patent Act of 1952 changed this area of the law. More specifically,

⁴ It should be noted that *Minnesota Mining & Manufacturing Co.*, supra, and *Dyer*, supra, both distinguish the *Hazeltine* case by stating that it "merely held that . . . (since) all of the copending references relied upon therein failed, either singly or in combination to disclose the claims of the later applicant, they did not prevent the issuance of a patent to him as the first inventor. (Furthermore) . . . the Court held, on the merits, that the facts of that case clearly revealed invention." At 100 F.2d 429, 432.

counsel states that since 35 U.S.C. 103 sets forth that "a patent may not be obtained . . . if the difference between the (claimed) subject matter . . . and the prior art . . . would have been obvious *at the time the invention was made*", (Emphasis added), a "copending patent" may not be considered a part of the prior art under Section 103 because "at the time the invention was made" the disclosure therein was not publicly available knowledge due to requirements of 35 U.S.C. 122.

However, counsel for plaintiffs overlooks the fact that "Section 103 . . . is not concerned with the psychological aspects of inventing, but rather with the legal concepts involving hypothetical situations in which the prior art is assumed to include those things dealt with in Section 102". *In re Kander*, 312 F.2d 834, 136 U.S.P.Q. 477 (C.C.P.A. 1963). In other words, that section contemplates an objective standard of patentability, and "the inventor may indeed have made an invention in the psychological sense, but it would nevertheless not be patentable if the quantum of novelty over the prior art material of which he may have been in total ignorance was not sufficient". Federico, *Commentaries On The New Patent Act*, 35 U.S.C.A., at p. 21. Thus, where the technology in a particular art has developed to such a state that "a person having ordinary skill in the art" would find that a certain invention was obvious in view of this state of the art, the invention is not patentable regardless of whether or not it would have been possible for that particular inventor to know the entire state of the art.

Therefore, in view of the fact that the "prior art" under 35 U.S.C. 103 is not limited to materials which an inventor knows or could reasonably be expected to know, the question of whether a copending patent is to be considered a part of the "prior art" under 35 U.S.C. 103 is a matter of policy. Because of the fact that the policy, the case law, prior to the 1952 Act was to include "co-

pending patents" in the prior art in situations analogous to those now covered by Section 103, it is the opinion of the Court that there would have to be clear, unmistakable language in the Patent Act of 1952, or in its legislative history⁵ before a Court would be warranted in holding that "copending patents" are not "prior art" under 35 U.S.C. 103.

The Court has not found, nor has Counsel for plaintiffs directed its attention to any such language. The Patent Act is unclear on this point; however, the legislative history noted by the Court indicates that the draftsmen of the 1952 Act intended to have "copending patents" be considered as part of the prior art under Section 103. See *Legislative History—Title 35, United States Code* in 2 U. S. Code Cong. & Ad. News, at p. 2399. Moreover, one of the draftsmen⁶ of the 1952 Act, states that "the antecedent of the words 'the prior art' (in 35 U.S.C. 103), . . . lies in the phrase 'disclosed or described as set forth in Section 102', and hence these words refer to material specified in Section 102 as the basis for comparison." Federico, *Commentary On The New Patent Act*, 35 U.S.C.A., p. 20.

While neither the Supreme Court nor the Court of Appeals in this Circuit have ruled on this specific point, the Court of Customs and Patent Appeals has held that the term "prior art" in 35 U.S.C. 103 is assumed to include "copending patents". *In re Gregg*, 244 F.2d 316, 113 U.S.P.Q. 526 (C.C.P.A. 1957), and *In re Kander*, supra. That Court in *In re Gregg*, supra, stated:

"It was well settled prior to the 1952 Act that a patent issued on an application which was copending with that of another applicant could properly be used as a reference against the claims of the other applicant even though it did not disclose everything claimed, and it

⁵ See generally, Rich, *Congressional Intent or, Who Wrote The Patent Act of 1952?*, in PATENT PROCUREMENT AND EXPLOITATION 61 (BNA 1963).

⁶ *Ibid.*

was necessary to combine it with other references. (Citation omitted.) There is nothing to indicate that any change in that practice was contemplated by the Congress when it enacted the Patent Act of 1952." At p. 318.

In view of the above, the Court holds that the Patent Act of 1952 did not change the prior law and that "copending patents" are included in the "prior art", as that term is used in 35 U.S.C. 103.

Counsel for plaintiffs has also contended that if this Court holds, as it has above, that copending patents are prior art under Section 103, Section 102(e) will be rendered meaningless because there would be no need for it. That contention is not sound. If it were, the same rationale would apply, for example, to the publications and patents specified in 35 U.S.C. 102(a) and (b). However, it is beyond question that such publications and patents are a part of the prior art under 35 U.S.C. 103.

Therefore, for the reasons set forth above, the Court finds for the defendant and against the plaintiff, and hereby dismisses the Complaint in this case.

The foregoing Opinion includes Findings of Fact and Conclusions of Law.

Dated: February 14, 1964.

JOSEPH R. JACKSON

United States District Judge

Paper No. 16

IN THE UNITED STATES PATENT OFFICE

Appeal No. 290-98

BEFORE THE BOARD OF APPEALS

Mailed Mar. 28, 1962

U.S. Patent Office, Board of Appeals

Ex parte Robert Regis

Application for Patent filed December 23, 1957, Serial No. 704,770. Microwave Switch.

Messrs. Laurence B. Dodds, Edward A. Ruestow, and Andrew L. Ney for appellant.

Before McCann, Kreek and Keely, Examiners-in-Chief.
Keely, Examiner-in-Chief.

This is an appeal from the final rejection of Claims 1, 2 and 3, all the claims now in the case.

Claim 1 is representative and reads as follows:

1. A microwave switch for selectively isolating a microwave source from its load comprising: a microwave signal guide for connection to a microwave source at one end and to a load at the other end; and an attenuator vane of resistive material having a tapered end extending toward said source and having a highly conductive strip at the other end thereof and displaceable in and out of said guide for selectively isolating said source from its load when in said guide while maintaining an approximate impedance match to said source.

The references relied upon are:

Carlson	2,491,644	Dec. 20, 1949
Wallace et al.	2,822,526	Feb. 4, 1958

The rejected claims relate to a microwave switch which is adequately described in appellant's brief to which reference is made.

The claims stand rejected as being unpatentable over Wallace et al. in view of Carlson.

It is asserted by the Examiner that appellant has conceded that if the patent to Wallace et al. is available as a reference then it may be combined with Carlson and that the combination negatives invention in the instant case.

It is the position of the Examiner that prior to the 1953 (sic) Patent Act copending patents either singularly or in combination were valid references. He contends that said Act has not changed this situation and he cites our decisions *Ex parte* Teague et al., 108 USPQ 380; *Ex parte* Machlanski, 111 USPQ 459; and *Ex parte* Kuzmitz, 113 USPQ 255 as well as the Court of Customs and Patent Appeals decision in *In re Gregg*, 44 CCPA 904, 1957 C.D. 284, 720 O.G. 227, 244 F. (2d) 316, 113 USPQ 526 as supporting his position.

Appellant challenged the rejection contending that Wallace et al. is not prior art and for this reason cannot be combined with Carlson.

It is urged by appellant that 35 U.S.C. 102 requires that an appellant must be granted a patent unless one of the prohibitions of the seven sub-paragraphs of this section applies. He considers sub-paragraphs (a), (e) as being the only ones applicable. Pointing to the term "the invention" of these paragraphs he argues that the quoted term requires that his complete device must be found in a single reference before Section 102 is applicable.

He submits that his arguments are fortified by the terms of 35 U.S.C. 103, which uses the following language in referring to 35 U.S.C. 102,

"... not identically disclosed or described as set forth in section 102"

He concludes that Section 102 restricts the prior art to a single reference, and that Section 103 was intended to supply the only exception.

Turning next to Section 103, he urges that if this Section relates to copending patents then it would be in conflict with Section 102(e) and the latter would be unnecessary. He contends that such an interpretation of the statutes is improper and that Section 102(e) is to stand alone in relation to copending patents.

He considers that his reasoning that Section 103 is inapplicable to copending patents is reinforced by Section 122 which requires that patent applications be kept in secrecy, as well as by numerous decisions holding that copending patents are not part of the prior art for the simple reason that the patent application is not publicly available until the patent issues.

We have reviewed the pertinent sections of the statutes and case law in the light of the Examiner's and appellant's remarks and as a result of our review are in full accord with the position of the Examiner.

It appears to us that the issues raised by appellant have been decided by the Court of Customs and Patent Appeals in *In re Gregg* as well as by us in our previous decisions cited above.

The arguments in appellant's brief appear to be pointless. On page 6, appellant admits that 35 U.S.C. 102(e) enacts the rule of *Milburn Co. v. Davis Bournonville Co.*, 1926 C.D. 303, 344 O.G. 817, 270 U.S. 390, which held that a patent was a reference for what it disclosed as of its filing date.

It is obvious that Wallace et al., as of his filing date, had the structure necessary for modifications in the light of Carlson to achieve the disputed claimed structure. Appellant has admitted that the modification is obvious. Under these circumstances the claimed structure was ob-

vously within the grasp of Wallace et al. about three years and nine months prior to appellant's entry into the field.

Section 103, as we view it, concerns itself only with the circumstances under which a reference that is not anticipatory of the claimed device or method may be used. This section complements sub-paragraphs (a), (b), (e) and (g) of 102 without indicating the type of evidence which will be used to establish obviousness, the qualification of the evidence being found in other sections of the statute and pertinent case law, as for example the cases cited above.

Accordingly, we will sustain the rejection of the claims.

We have carefully considered the contentions and arguments presented in appellant's brief but we are of the opinion that the Examiner's rejection was proper and it will be sustained.

The decision of the Examiner is affirmed.

AFFIRMED

/s/ L. P. McCann
Examiner-in-Chief

/s/ Louis F. Kreek
Examiner-in-Chief

/s/ J. E. Keely
Examiner-in-Chief

Board of Appeals